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PETER J. GORDON, PATENT COUNSEL
AVID TECHNOLOGY, INC.
ONE PARK WEST
TEWKSBURY, MA 01876

EXAMINER	
TERMANINI, SAMIR	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/669,673	FASCIANO, PETER J.	
	Examiner	Art Unit	
	Samir Termanini	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on *12 February 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-27* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *23 September 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *2/12/2007*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

BACKGROUND

1. This Office Action is responsive to the following communications: Amendment filed on 2/12/2007.

2. Claims 1-27 are pending in this case. Claims 4, 8, 19, and 25 have been amended. Claims: 1, 7-8, 18, 21, and 25-27 are in independent form.

3. Applicant's amendment of Claims 4 and 19 obviate the objections cited by the Examiner in the previous Office Action (Mail dated 8/11/2006) with regard to punctuation.

INFORMATION DISCLOSURE STATEMENT

4. The information disclosure statement (IDS) filed on 2/12/2007 has been acknowledged and considered by the examiner. The Initial copy of form PTO-1449 is included in this office action.

CLAIM REJECTIONS - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-16, 18-20, and 25-26 are rejected under 35 U.S.C. 102(e) as being anticipated by *Balabanovic et al.* (US 2005/0283741 A1).

As to independent **claim 1**, *Balabanovic et al.* disclose a system for exhibiting stored digital media assets to one or more users (System, paragraph [0014]; *See also* Fig. 7), comprising: means for traversing an index of the digital media assets to repeatedly select digital media assets without direction defined according to the user (automatic input into the system without user direction, paragraph [0025]); means for sequentially presenting the selected digital media assets to a client (slideshow of images, paragraph [0025]); and means for storing information at the client (interface 100, paragraph [0029]) regarding selected ones of the presented digital media assets (track 115 shows story being authored via the selection, paragraph [0035]).

As to independent **claim 7,** *Balabanovic et al.* disclose a system for exhibiting stored digital media assets to one or more users (System, paragraph [0014]), comprising: means for traversing an index of the digital media assets to repeatedly select digital media assets without direction defined according to the user (automatic input into the system without user direction, paragraph [0025]); means for sequentially

presenting the selected digital media assets to a client (slideshow of images, paragraph [0025]); and means for permitting a user at the client to provide an input indicative of interest in a presented digital media asset (add button 230, paragraph [0053]; *See also* Fig. 2).

As to independent **claim 8,** *Balabanovic et al.* teach a computer-implemented method for facilitating definition of a storyline using stored digital media assets ("...the system allows the user to create new stories..." *emphasis added,* paragraph [0026]), comprising: selecting digital media assets from among the stored digital media assets (automatic input into the system without user direction, paragraph [0025]); sequentially exhibiting the selected digital media assets to a user (slideshow of images, paragraph [0025]; *See also* Figs. 1-3), such that at any point in time one of the exhibited selected digital media assets becomes a currently exhibited digital media asset ("...image 120 corresponds to thumbnail image currently...selected...," paragraph [0040]); receiving an input from the user indicative of the user's interest in the currently exhibited digital media asset during said exhibition (add button 230, paragraph [0053]; *See also* Fig. 2); and storing, as a sequence of scenes representing a storyline, information regarding the user's interest in the currently exhibited digital media asset (i.e. "...photographs selected by an individual... appears as a sequence of thumbnail images." paragraph [0035]).

As to independent **claim 18,** *Balabanovic et al.* disclose a computer-implemented method for exhibiting stored digital media assets ("...displaying digital media objects to a user...", paragraph [0024]), comprising: randomly selecting digital media assets from

among the stored digital media assets (ordered by time of creation or other such features, paragraph [0031]; or database query, paragraph [0032]); exhibiting the selected digital media assets to a user (slideshow of images, paragraph [0025]; *See also* track 105, Fig. 1), whereby at least one of the exhibited selected digital media assets becomes a currently exhibited digital media asset("...image 120 corresponds to thumbnail image currently...selected...," paragraph [4000]); receiving an input from the user indicative of the user's interest in the currently exhibited digital media asset (add button 230, paragraph [0053]; *See also* Fig. 2); and storing information regarding the user's interest in the currently exhibited digital media asset including an indication of the exhibited digital media asset (e.g. "storied" 55, 535, 530, 540, Fig. 5B).

As to independent **claim 25**, *Balabanovic et al.* teach a computer program product, comprising: a computer readable medium; computer program instructions stored on the computer readable medium that, when processed by a computer, instructs the computer to perform a method for facilitating definition of a storyline using stored digital media assets, comprising (computer program product, and readable storage medium, paragraph [0017]): selecting digital media assets from among the stored digital media assets (automatic input into the system without user direction, paragraph [0025]); sequentially exhibiting the selected digital media assets to a user, such that at any one point in time only one of the exhibited selected digital media assets becomes a currently exhibited digital media asset; ("...image 120 corresponds to thumbnail image currently...selected...," paragraph [0040]); receiving an input from the user indicative of the user's interest in the currently exhibited digital media asset during said

exhibition (add button 230, paragraph [0053]; *See also* Fig. 2); and storing, as a sequence of scenes representing a storyline, information regarding the user's interest in the currently exhibited digital media asset (i.e. "...photographs selected by an individual... appears as a sequence of thumbnail images." paragraph [0035]) wherein the information includes at least an indication of the exhibited digital media asset (Fig. 5A, 5B, and Fig.6).

As to independent **claim 26**, *Balabanovic et al.* a computer program product, comprising: a computer readable medium; computer program instructions stored on the computer readable medium that, when processed by a computer, instructs the computer to perform a method for exhibiting stored digital media assets, comprising: (computer program product, and readable storage medium, paragraph [0017]) randomly selecting digital media assets from among the stored digital media assets (ordered by time of creation or other such features, paragraph [0031]; or database query, paragraph [0032]); exhibiting the selected digital media assets to a user (slideshow of images, paragraph [0025]; *See also* Figs. 1-3), whereby at least one of the exhibited selected digital media assets becomes a currently exhibited digital media asset (add button 230, paragraph [0053]; *See also* Fig. 2); receiving an input from the user indicative of the user's interest in the currently exhibited digital media asset (add button 230, paragraph [0053]; *See also* Fig. 2); and storing information regarding the user's interest in the currently exhibited digital media asset(i.e. "...photographs selected by an individual... appears as a sequence of thumbnail images." paragraph [0035]), wherein the information includes at least an indication of the exhibited digital media asset (Fig. 5A, 5B, and Fig.6).

As to dependent **claims 2 and 3**, *Balabanovic et al.* further disclose that the means for storing includes means for permitting a user at the client to provide an input indicative of interest in a presented digital media asset (add button 230, paragraph [0053]; *See also* Fig. 2) and an indication of the source of the presented digital media asset at the client (Metadata file, paragraph [0063]) in a manner that allows retrieval of the presented digital media asset (where references are in the form of a URL, paragraph [0063]).

As to dependent **claims 4 and 5**, *Balabanovic et al.* further teach the means for storing to include a means for storing at the client a history describing recently presented digital media assets (the top track 115 may contain a user's chronological browsing history, paragraph [0071]) and the client to includes a means for manipulating the history to review the presented assets (second track for later retrieval, paragraph [0071]).

As to dependent **claim 6**, *Balabanovic et al.* further teach the traversal is to be apparently random (ordered by time of creation or other such features, paragraph [0031]; or database query, paragraph [0032]).

As to dependent **claim 9** *Balabanovic et al.* further teach selecting comprises randomly selecting digital media assets from among the stored digital media assets(ordered by time of creation or other such features, paragraph [0031]; or database query, paragraph [0032]).

As to dependent **claim 10**, *Balabanovic et al.* further teach that the exhibiting comprises periodically initiating an update of a display, including displaying a digital media asset from among the selected digital media assets, wherein the displayed digital media asset is different from the currently exhibited digital media asset (slideshow of

images, paragraph [0025]; *See also* Figs. 1-3) and, when displayed, becomes the currently exhibited digital media asset (showing, paragraph [0025]; *See also* "play screen saver feature is activated causing the screen to cycle through all the stories in the system" at paragraph [0067]).

As to dependent **claim 11**, *Balabanovic et al.* further teach the input indicative of the user's interest includes an input (add button 230, paragraph [0053]; *See also* Fig. 2) through a mechanical user interface of a computer (pointing device 708, Fig. 7).

As to dependent **claim 12**, *Balabanovic et al.* further teach receiving the input occurs during exhibition of the currently exhibited digital media asset ("add button 230 adds the currently displayed image to the working set, paragraph [0052]).

As to dependent **claim 13**, *Balabanovic et al.* further teach the input to further included an indication of a reason for the user's interest in the currently exhibited digital media asset (annotate as part of the story currently being authored, paragraph [0038]).

As to dependent **claims 14 and 15**, *Balabanovic et al.* further teach that the input comprises an indication of a lack of an interest and for a reason for said lack of interest in the currently exhibited digital media asset (remove button 235, paragraph [0053]; *See also* annotation at paragraph [0038]).

As to dependent **claim 16 and 19**, *Balabanovic et al.* further teach that each scene in the sequence of scenes is represented by a folder, and wherein storing comprises storing an indication of the currently exhibited digital media asset in the folder ("In the second track, a story might correspond to a bookmark folder, a series of pages found in the course of one search, or any other structure as is useful to the user." paragraph [0071]) and that

storing comprises: storing a history describing recently exhibited digital media assets (*See above* at paragraph [0071]).

As to dependent **claim** 20, *Balabanovic et al.* further teach receiving an input from the user for manipulating the history to review the previously exhibited digital media assets (user's chronological browsing history, paragraph [0071]).

CLAIM REJECTIONS - 35 USC §103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. **Claims 17, 21-24, and 27** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Balabanovic et al.* in view of *Boreczky et al.* (US 6,366,296 B1)

As to independent **claim 21**, *Balabanovic et al.* teach a computer-implemented method for facilitating definition of a sequence of scenes representing a storyline using digital media assets ("...the system allows the user to create new stories..." emphasis added, paragraph [0026]), wherein each scene has associated metadata (metadata, [0061], See also Fig.4) the method comprising: exhibiting the digital media assets to a user (slideshow of images, paragraph [0025]; See also Figs. 1-3), whereby at least one of the exhibited digital media assets becomes a currently exhibited digital media asset ("...image 120 corresponds to thumbnail image currently...selected...," paragraph

[0040]), wherein the currently exhibited digital media asset has associated metadata (story pointed to by metadata file 500, paragraph [0063]). *Balabanovic et al.* does not expressly disclose comparing of the metadata of each scene with the metadata of the currently exhibited media asset and displaying to the user an indication of relevance of the currently exhibited digital media asset scenes according to the result. *Boreczky et al.* has been cited for teaching the comparing of the metadata of each scene (selected feature, col. 2 ln. 37) with the metadata of the currently exhibited media asset (media file being browsed, col. 2 ln. 33) and displaying to the user an indication of relevance of the currently exhibited digital media asset scenes according to the result (feature indicator, col. 2 ln. 20-25). It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have used the comparative metadata indicator as taught by **Boreczky et al.** to the digital media asset associated with metadata of *Balabanovic et al.* because *Boreczky et al.*: (1) is directed to the same problem of identifying interest in media files; (2) is in the same field of endeavor of reviewing aural, visual, or other representations of media files; and (3) *Boreczky et al.* expressly suggests that "Providing feature information in a media browsing system can be very useful for a user when identifying areas of interest in a media file, controlling media playback, editing a media file, or performing other operations with a media file." (col. 1, ln. 60-64).

As to independent **claim 27**, *Balabanovic et al.* teach a computer program product, comprising: a computer readable medium; computer program instructions stored on the computer readable medium that, when processed by a computer, instructs

the computer to perform a method for facilitating definition of a sequence of scenes representing a storyline using digital media assets, wherein each scene has associated metadata, the method comprising: (computer program product, and readable storage medium, paragraph [0017]) exhibiting the digital media assets to a user exhibiting the digital media assets to a user (slideshow of images, paragraph [0025]; See also Figs. 1-3), whereby at least one of the exhibited digital media assets becomes a currently exhibited digital media asset("...image 120 corresponds to thumbnail image currently...selected...," paragraph [0040]), wherein the currently exhibited digital media asset has associated metadata; comparing the metadata of each scene with the metadata of the currently exhibited media asset (story pointed to by metadata file 500, paragraph [0063]). *Balabanovic et al.* does not expressly disclose displaying to the user an indication of relevance of the currently exhibited digital media asset to at least one of the scenes according to a result of the comparison. *Boreczky et al.* is cited for teaching displaying to the user an indication of relevance of the currently exhibited digital media asset to at least one of the scenes according to a result of the comparison. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have used the comparative metadata indicator as taught by *Boreczky et al.* to the digital media asset associated with metadata of *Balabanovic et al.* because *Boreczky et al.*: (1) is directed to the same problem of identifying interest in media files; (2) is in the same field of endeavor of reviewing aural, visual, or other representations of media files; and (3) *Boreczky et al.* expressly suggests that "Providing feature information in a media browsing system can be very useful for a user when identifying areas of interest in a

media file, controlling media playback, editing a media file, or performing other operations with a media file." (col. 1, ln. 60-64).

As to dependent **claim 17**, *Balabanovic et al.* teach the limitations previously discussed with respect to claim 8, above. *Balabanovic et al.* does not expressly disclose that a scene has associated metadata and the currently exhibited digital media asset has associated metadata, and wherein exhibiting comprises: comparing the metadata of the scene with the metadata of the currently exhibited media asset; and displaying to the user an indication of a result of the comparison. *Boreczky et al.* is cited for teaching that the scene has associated metadata (metadata, Fig. 5A) and the currently exhibited digital media asset has associated metadata (metadata,Fig. 6), and wherein exhibiting comprises: comparing the metadata of the scene (selected feature, col. 2 ln. 37); with the metadata of the currently exhibited media asset (media file being browsed, col. 2 ln. 33); and displaying to the user an indication of a result of the comparison (feature indicator, col. 2 ln. 20-25). It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have used the comparative metadata indicator as taught by *Boreczky et al.* to the digital media asset associated with metadata of *Balabanovic et al.* because *Boreczky et al.*: (1) is directed to the same problem of identifying interest in media files; (2) is in the same field of endeavor of reviewing aural, visual, or other representations of media files; and (3) *Boreczky et al.* expressly suggests that "Providing feature information in a media browsing system can be very useful for a user when identifying areas of interest in a media file, controlling media

playback, editing a media file, or performing other operations with a media file." (col. 1, ln. 60-64).

As to dependent **claim 22**, *Balabanovic et al.* teach the limitations previously discussed with respect to claim 21 above, further comprising receiving an input from a user indicative of the user's interest in the currently exhibited digital media asset (add button 230, paragraph [0053]; See also Fig. 2); storing information regarding the user's interest in the currently exhibited digital media asset, wherein the information includes at least an indication of the exhibited digital media asset (i.e. "...photographs selected by an individual... appears as a sequence of thumbnail images." paragraph [0035]). *Balabanovic et al.* does not expressly disclose comparing of the metadata of each scene with the metadata of the currently exhibited media asset and displaying to the user an indication of relevance of the currently exhibited digital media asset scenes according to the result. *Boreczky et al.* further teach comparing of the metadata of each scene (selected feature, col. 2 ln. 37) with the metadata of the currently exhibited media asset (media file being browsed, col. 2 ln. 33) and displaying to the user an indication of relevance of the currently exhibited digital media asset scenes according to the result (feature indicator, col. 2 ln. 20-25). Thus, the combination of *Balabanovic et al.* and *Boreczky et al.* meet the claimed limitations for the same reasons set forth in the discussion of claim 21 above.

As to dependent **claim 23**, *Balabanovic et al.* teach the limitations previously discussed with respect to claim 21 above, further comprising storing information regarding the currently exhibited digital media asset in association with at least one of

the scene (e.g. "storied" 55, 535, 530, 540, Fig. 5B). *Balabanovic et al.* does not expressly disclose comparing of the metadata of each scene with the metadata of the currently exhibited media asset and displaying to the user an indication of relevance of the currently exhibited digital media asset scenes according to the result. *Boreczky et al.* further teach comparing of the metadata of each scene (selected feature, col. 2 ln. 37) with the metadata of the currently exhibited media asset (media file being browsed, col. 2 ln. 33) and displaying to the user an indication of relevance of the currently exhibited digital media asset scenes according to the result (feature indicator, col. 2 ln. 20-25). Thus, the combination of *Balabanovic et al.* and *Boreczky et al.* meet the claimed limitations for the same reasons set forth in the discussion of claim 21 above.

As to dependent **claim 24**, *Balabanovic et al.* teach the limitations previously discussed with respect to claim 21 above, further comprising receiving an input from a user indicative of a scene with which the user wants to associate the currently exhibited digital media asset (e.g. control buttons, paragraph [0020]) and storing information regarding the currently exhibited digital media asset in association with the indicated scene (e.g. playlists, paragraph [0020]). *Balabanovic et al.* does not expressly disclose comparing of the metadata of each scene with the metadata of the currently exhibited media asset and displaying to the user an indication of relevance of the currently exhibited digital media asset scenes according to the result. *Boreczky et al.* further teach comparing of the metadata of each scene (selected feature, col. 2 ln. 37) with the metadata of the currently exhibited media asset (media file being browsed, col. 2 ln. 33) and displaying to the user an indication of relevance of the currently exhibited

digital media asset scenes according to the result (feature indicator, col. 2 ln. 20-25). Thus, the combination of *Balabanovic et al.* and *Boreczky et al.* meet the claimed limitations for the same reasons set forth in the discussion of claim 21 above.

RESPONSE TO ARGUMENTS

I. Objections: Claims 4 and 19.

Applicant's amendment of Claims 4 and 19 obviate the objections cited by the Examiner in the previous Office Action (Mail dated 8/11/2006) because periods were missing at the end of each claim. These objections are withdrawn in view of the amendment.

II. Rejections of Claims 1 and 7 under 35 U.S.C. §102(e): It is not persuasive to argue unclaimed limitations.

Applicant's arguments concerning the Examiner's rejections of claims 1 and 7 made under 35 U.S.C. §102(e) in view of *Balabanovic et al.* in the previous Office Action (dated 1/12/2007) have been fully considered but they are not persuasive.

Applicant argues that the claim language, "'without direction defined according to the user' indicates that the selection of the assets to be displayed to the user is machine-directed, so as to inject spontaneity into the search for digital media assets or to expose media assets that might otherwise remain concealed if they are not searched for."[1]

[1] See Applicant's amendment (dated: 2/12/2007), pp. 8–9 of 11.

The examiner respectfully acknowledges the Applicant's argument outlining the desired goals for the apparatus recited in claims 1 and 7, however, applicant is reminded that, "[a]pparatus claims cover what a device *is*, not what a device *does*."[2]

Assuming, *arguendo*, that under 35 U.S.C. 112, 6th paragraph, claims 1 and 7 are limited by intended use as applicant argues – nonetheless the result would same. A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teach all the structural limitations of the claim.[3] It should be noted that means plus function limitations are met by structures which are equivalent to the corresponding structures recited in the specification.[4]

Balabanovic et al. teach structures which are equivalent to the corresponding "general-purpose computer system" (Applicant's Spec., paragraph [0032]) recited in the specification (i.e. "System", Fig. 7; see also "stories may be generated automatically as a result of a database query," paragraph [0032]; see also "the selected track automatically scrolls forward to a next thumbnail image in the story," paragraph [0048]). Additionally, *Balabanovic et al.* teach a machine–directed implementation "[digital media assets] may be input into the system automatically without requiring any action from the user..." (paragraph [0022]) and that they, "...are then automatically accessible..." (paragraph [0022]) and still further, the selection of the assets to be

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[2] *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original).
[3] *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).
[4] *In re Ruskin*, 347 F.2d 843, 146 USPQ 211 (CCPA 1965) as implicitly modified by *In re Donaldson*, 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994). See also *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1951 (Fed. Cir. 1999).

displayed to the user is machine-directed via query, "...automatically as a result of a database query..." (paragraph [0032]).

III. Rejections of Claims 1 and 7 under 35 U.S.C. §102(e): The "...without direction defined according to the user..." limitation.

Applicant argues that the limitation: "without direction defined according to the user" is not taught by the cited reference because, "...all mechanisms [taught by the prior art reference] involve the user selecting which objects to view..."[5] and therefore the user is directing the selection.

Examiner respectfully dissents. The language of this particular limitation confines how the traversing means selects assets – not how the user selects assets.

As an initial matter, under 35 U.S.C. 112, sixth paragraph, a claim limitation expressed in means-plus-function language "...shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof."[6] Secondly, applicant has provided an embodiment illustrating how the limitation[7] can be practiced: "A simple implementation of such a system may be provided by modifying a so-called '*slide show_screen saver*' computer program...." (paragraph [0024])(emphasis added). Thirdly, *Balabanovic et al.* uses identical terminology to teach the means for repeatedly selecting digital media assets without direction defined according to the user, *inter alia*, "playing back a story involves

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[5] See Applicant's amendment (dated: 2/12/2007), p. 8 of 11.
[6] 35 U.S.C. §112, 6th Para.
[7] "...without direction defined according to the user....", in claims 1 and 7.

showing the user a *slideshow* of images along with any accompanying narrations...," paragraph [0025]; see also "...the plurality of digital media objects is played back sequentially as a slideshow...." Claim 74).

IV. Rejection of Claims 8 and 25 under 35 U.S.C. §102(e):: It is not persuasive to argue unclaimed limitations.

Applicant argues that *Balabanovic et al.* fails to teach input from a user representative of interest in a digital media asset being exclusively displayed from a sequence.[8] In advancing this argument Applicant asserts, "While *Balabanovic et al.* has a screen saver feature that cycles through all the stories in the system [paragraph 0067], *Balabanovic et al.* does not enable a user to select a currently displayed story during this screen saver operation."[9]

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies are not recited in the rejected claim(s). It is submitted that claims 8 and 25 do not require a screen saver operation. Furthermore, the limitation, "[s]equentially exhibiting" does not require the exhibiting to occur automatically, nor does it require the quantization of the exhibiting. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims.[10]

Applicant argues that the selection of an asset through "add button 230" [paragraph 0052] or an annotation [paragraph 0038] in *Balabanovic et al.*, is not

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[8] *See* Applicant's amendment (dated: 2/12/2007), p. 8 of 11.
[9] *See id.* at p. 8 of 11.
[10] *See In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

performed during the sequential exhibition of selected assets. This assertion cannot be maintained as *Balabanovic et al.* teach "pressing the add (+) button 230 adds the currently displayed image to the working set. Thus, the system appends the currently displayed image to the working set, but it does not stop the play mode." (paragraph [0052]) (emphasis added).

V. Rejection of Claims 18 and 26 under 35 U.S.C. §102(e): It is not persuasive to argue unclaimed limitations.

Applicant argues that these claims recite "randomly selecting digital media assets from among the stored digital media assets," and "exhibiting the selected digital media assets to a user..." and that "time of creation," or "database query," referred to in paragraph [0031] and [0032] of *Balabanovic et al.* does not anticipate.

Examiner respectfully disagrees. The claim language is explicitly defined in the specification as "any random or deterministic process for selecting items from a set such that the selected items, when presented in a sequence, do not appear to be in an ordered sequence." (Specification, paragraph [0014])(emphasis added). Pseudo–random processes are well known in the art, however, applicant has not provided anywhere in the specification a metric for which to judge when a sequence "appears" to be ordered.

There have been instances where claims were held indefinite because the meaning of a term depended on the unrestrained, subjective opinion of the person practicing the invention. Any special meaning assigned to a term "must be sufficiently

clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention."[11]

Balabanovic et al. teach several instances of a deterministic process for selecting items from a set such that the selected items, when presented in a sequence, do not appear to be in an ordered sequence. For example, pictures taken at random times, notwithstanding being "ordered according to when they were taken" (paragraph [0033]), still appear random. Also, pictures scanned in at random times, notwithstanding being "ordered by scanning time." (paragraph [0033]), still appear random. Especially since *Balabanovic et al.* teach that "[t]he selection of objects and the addition of narrations may be performed in any order," paragraph [0026]). Clearly, the deterministic ordering in *Balabanovic et al.* meets this definition.

VI. Rejection of Claims 17, 21–24, and 27 under 35 U.S.C. §103(a): It is not persuasive to argue unclaimed limitations.

Applicant's arguments concerning the Examiner's rejections of claims 17, 21–24, and 27 made under 35 U.S.C. §103(a) in view of *Balabanovic et al.* and *Boreczky* in the previous Office Action (dated 1/12/2007) have been fully considered but they are not persuasive.

In response to applicant's arguments against the references individually[12], one cannot show nonobviousness by attacking references individually where the rejections

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[11] *Multiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998).

[12] See Applicant's amendment (dated: 2/12/2007), para. 3–5, p. 10 of 11.

are based on combinations of references.[13] Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.[14]

Applicant argues there is no teaching or suggestion in either reference of "comparing the metadata of each scene, with the meta data of the currently selected media asset"[15] however *Boreczky* teach, *inter alia*, "Once metadata regarding the shot boundary feature is determined, information can be provided to a user to aid the user in locating portions of interest in the media file, e.g., places in the media file where scene changes occur." (col. 3, lines 54-60).

CONCLUSION

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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[13] *See In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).
[14] *See In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).
[15] See Applicant's amendment (dated: 2/12/2007), p. 10 of 11.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samir Termanini whose telephone number is (571) 270-1047. The examiner can normally be reached on 9AM-4PM, Mon.-Fri. (excluding alternating Fridays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

STEPHEN HONG
SUPERVISORY PATENT EXAMINER

Samir Termanini
Patent Examiner
Art Unit 2178